

Remarks

The applicants have carefully considered the final official action dated October 31, 2007. In the final official action, all of the claims were rejected as anticipated by Zimmer et al. (US Pub. No. 2004/0103272) (“Zimmer”). In view of the following remarks, reconsideration of the application is respectfully requested.

Rejection Under 35 U.S.C. § 112

Amended claims 14, 29, and 44 include the recitation: “wherein the value in the main memory is verified as identifying the temporary memory by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory.” The examiner contends that the claims, as amended, are not supported by the specification. However, the applicants respectfully submit that this contention is incorrect.

As an initial matter, the applicants note that the exact recitations of amended claims 1, 16, and 31 were present in claims 14, 29, and 44 in the originally filed application.

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).

(MPEP § 2163.06(III)). Therefore, if explicit support were need for the recitation identified by the examiner, the applicants could amend the specification to include subject-matter in the recitations.

However, the claims, as amended, are fully supported by the specification. To comply with the description requirement, it is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject

matter later claimed by him. *In re Edwards, Rice, and Soulen*, 568 F.2d 1349, 196 U.S.P.Q. 465, 467 (C.C.P.A. 1978).

The originally filed specification states

[0040] Conversely, if more pointer entries to be migrated exist (block 506), then the migrate storage process 416 **determines if the pointer entry is pointing at a location within the temporary memory heap 308 of FIG. 3 (block 508). One possible implementation may be to check if the pointer value is greater than or equal to the value of the top of heap temporary memory location 310 of FIG. 3 and the pointer value is less than the value of the bottom of heap temporary memory 312 of FIG. 3.** If the pointer entry is not pointing at a location within the temporary memory heap 308 of FIG. 3 (block 508), then the migrate storage process 416 determines if more pointer entries need to be migrated (block 506).

[0041] Conversely, if the pointer entry is pointing to a location within the temporary memory heap 318 of FIG. 3 (block 508), then the pointer entry is migrated (block 510). One possible implementation, which assumes that temporary memory is higher in memory than main memory, is to set the pointer to the pointer value minus the migration factor.

(Specification, Para. [0040]-[0041]) (emphasis added).

Paragraph [0040] describes determining if the pointer is pointing within the temporary memory heap. For the pointer to be pointing within the temporary memory heap, the pointer must either (1) identify an address within the temporary memory heap or (2) must identify an address not outside of the temporary memory heap. Paragraph [0040] provides one example of how to check if the pointer is pointing outside the memory heap by checking if the pointer value is greater than the value of the top of the temporary memory and less than the bottom of the temporary memory (i.e., is pointing outside of the range of the temporary memory).

Paragraph [0041] describes that the pointer entry is migrated only if the pointer entry is pointing to a location within the temporary memory heap. Clearly, one of ordinary skill in the art would have understood based on Paragraph [0040] that, to determine if the pointer

entry is pointing within the temporary memory heap (Para. [0041]), it should be determined if the pointer value is inside the range of the temporary memory location (as recited in the amendments to the claims). In other words, it is to be determined if the pointer value is greater than the bottom of the temporary memory heap and less than the top of the temporary memory heap.

Accordingly, while the specification does not state the exact wording of the claims, this wording has been present in the claims from the beginning and the specification reasonably conveys to persons skilled in the art that the inventors of the instant application had possession of the claimed invention. Therefore, the specification meets the requirements of 35 U.S.C. § 112 for the amended claims. The applicants respectfully request that the rejection be withdrawn.

Finality of the Official Action

It is respectfully submitted that the finality of the official action is improper because the applicants' amendments in the response to the official action filed October 19, 2007, did not necessitate new grounds of rejection. The amendments to claims 1, 16, and 31 were merely an incorporation of all of the recitations of dependent claims 14, 29, and 44, respectively. Even if the examiner disagrees that the rejection under 35 U.S.C. § 112 is improper, the examiner had an opportunity to make the rejection under 35 U.S.C. § 112 in any of the previous three official actions.

In addition, the new grounds of prior art rejection using US Pub. No. 2004/0103272 for claims previously rejected under 35 U.S.C. § 103 over the same reference in combination with a second reference appear to be based on the applicants statements in the response to the official action filed October 19, 2007, disqualifying US Pub. No. 2004/0103272 for use in a

rejection under 35 U.S.C. § 103. This disqualification is not a ground for the examiner to make the official action final.

When applying any 35 U.S.C. 102(e)/ 103 references against the claims of an application ** the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/ 103 rejection and the claims are not amended, the **examiner may not make the next Office action final if a new rejection is made.** See MPEP § 706.02(1)(3).

(MPEP § 706.07(a)) (emphasis added). In this case, the only amendments to the claims were to incorporate the subject-matter of dependent claims. No subject-matter was removed and no new subject-matter was added to the claims. Accordingly, the applicants respectfully request that finality of the official action be withdrawn.

Rejection Under 35 U.S.C. § 102

In the Office action, claims 1-13, 15-28, 30-43, and 45 are rejected under 35 U.S.C. § 102. In the previous Office action, mailed on July 19, 2007, claims 14, 29, and 44 were rejected as unpatentable under 35 U.S.C. § 103 over two references (Zimmer and Meyer). All of the subject-matter of claims 14, 29, and 44 has been incorporated into claims 1, 16, and 31, respectively. Claims 1, 16, and 31 (and their dependents) are now rejected as unpatentable solely over Zimmer.

The rejection of claim 1 under 35 U.S.C. § 102 is improper. As an initial matter, the applicants note that the examiner rejected recitations different from the recitations of claim 1 (see official action, Page 3, lines 13-16). In addition, the rejection did not cite any portion of Zimmer as describing the final recitation of claim 1 (see official action, page 5, lines 8-13). Rather, the rejection merely states a conclusion that such a recitation is described in Zimmer without providing any support for such a conclusion. Accordingly, the applicants

respectfully submit that the rejection is improper and must be withdrawn or a new non-final rejection must be provided that rejects the recitations of claim 1 with arguments supported by the descriptions in the prior art.

The applicants further submit that claim 1 is patentable over Zimmer. In particular, Zimmer does not describe or suggest “wherein the value in the main memory is verified as identifying the temporary memory by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory” as recited in claim 1. In particular, even if Zimmer describes moving data from a temporary memory to a main memory, Zimmer does not describe or suggest verifying that a value in main memory identifies a temporary memory location by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory. Rather, Zimmer merely states “Upon initialization of permanent or system memory 25, the cache code and data may be copied to permanent or system memory 25.” (Zimmer, Para. [0020]). Even if the examiner’s contention that migrating the copied data and modifying a value in the main memory is inherent in such a state, a point which the applicants do not concede, it is not clear why it would be inherent to verify the value in the main memory as identifying the temporary memory by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory. Therefore, claim 1 and all claims depending therefrom are patentable over the cited art.

Claim 16 recites, *inter alia*, wherein the value in the main memory is verified as identifying the temporary memory by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory. As described in conjunction with claim 1, the cited art does not describe or suggest wherein the value in the main memory is verified as identifying the temporary memory by determining if the value is

greater than a bottom of the temporary memory and is less than a top of the temporary memory. Accordingly, for at least the forgoing reasons, claim 16 and all claims depending therefrom are patentable over the cited art.

Claim 31 recites, *inter alia*, wherein the value in the main memory is verified as identifying the temporary memory by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory. As described in conjunction with claim 1, the cited art does not describe or suggest wherein the value in the main memory is verified as identifying the temporary memory by determining if the value is greater than a bottom of the temporary memory and is less than a top of the temporary memory. Accordingly, for at least the forgoing reasons, claim 31 and all claims depending therefrom are patentable over the cited art.

Thus, for at least the foregoing reasons, the applicants respectfully submit that all pending claims are now in condition for allowance. If there are any remaining issues in this application, the applicants urge the examiner to contact the undersigned agent at the number listed below.

Respectfully submitted,
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Dated: December 31, 2007

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